



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/901,692	07/28/1997	AKIRA KAMAKURA	1095.1076/JD	9430

21171 7590 01/15/2002

STAAS & HALSEY LLP
700 11TH STREET, NW
SUITE 500
WASHINGTON, DC 20001

EXAMINER

KAZIMI, HANI M

ART UNIT

PAPER NUMBER

2164

DATE MAILED: 01/15/2002

22

Please find below and/or attached an Office communication concerning this application or proceeding.

2001

H.G

Office Action Summary

Application No.

08/901,692

Applicant(s)

KAMAKURA ET AL.

Examiner

Hani Kazimi

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 1997 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 2164

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on October 23, 2001.

Status of Claims

2. Of the original Claims 1-10, claims 1, and 2 have been amended by Applicants' amendment filed on March 25, 1999. The same amendment has added claims 11-14. In the amendment filed on March 10, 2000, claims 2, and 13 have been canceled, and claims 1, 11, 12, and 14 have been amended. In the amendment filed on August 10, 2000, claim 3 has been amended. In the amendment filed on February 26, 2001, claim 14 has been amended. In the amendment filed on October 23, 2001, claim 1 has been amended, and claims 15, and 16 have been added. Therefore, claims 1, 3-12, and 14-16 are under prosecution in this application.

Response to Applicant's Amendment

3. Applicants' amendment and arguments filed on October 23, 2001 have been fully considered, and discussed in the next section below or within the following rejections under 35 U.S.C. § 102 and § 103 are not deemed to be persuasive, and Applicants' request for allowance is respectfully denied.

Art Unit: 2164

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claim 15 is rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. US Patent No. 5,794,207.

Claim 15, Walker teaches a marketing system for processing market information of consumers and dealers via an electronic network (abstract, and figure 1), comprising:

a communication unit coupled to the electronic network to communicate with a consumer and a dealer (figure 1, column 11, lines 53-65);

a storage unit to store personal information of the consumer and market information about goods which the consumer desires to purchase (figure 2, element 255, column 13, lines 1-10, and figure 5, elements 510-550, column 15, line 60 thru column 16, line 45); and

a processing unit, coupled to said storage unit and said communication unit, to provide personal information of the consumer necessary for the dealer to access the consumer after the market information is purchased by the dealer (column 13, lines 1-53, and column 19, lines 55-60).

Art Unit: 2164

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

8. Claims 1, 3-12, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. US Patent No. 5,794,207 (hereinafter "Walker '207") in view of Walker et al. US Patent No. 5,884,270 (hereinafter "Walker '270").

Claims 1, and 11, 12, 14, and 16, Walker '207 teaches a marketing system and method for processing market information of consumers and dealers via an electronic network (abstract, and figure 1), comprising:

Art Unit: 2164

personal information registering means for registering personal information of a consumer (figure 2, element 255, and column 13, lines 1-10);

market information registering means for registering market information about services which the consumer desires to purchase (figure 5, elements 510-550, and column 15, line 60 thru column 16, line 45);

posting means for extracting and posting the market information registered in said market information registering means according to genres (column 15, line 46 thru column 16, line 11, column 17, lines 8-26, and column 27, lines 20-36); and

personal information acquiring means for acquiring for a dealer personal information of the consumer necessary for the dealer to access the consumer from said personal information registering means after the market information posted at said posting means is purchased by the dealer (column 13, lines 1-53, and column 19, lines 55-60).

Walker '207 fails to teach the prior approval demand determining means for determining, based on the personal information registered in said personal information registration means, whether prior approval by the consumer is required before the dealer accesses the consumer, and access confirming means for seeking approval for access by the dealer from the consumer who registered the purchased market information, when prior approval is required.

Walker '270 teaches the steps of determining, based on the personal information registered in said personal information registration means, whether prior approval by the candidate is required before the employer accesses the candidate, and seeking approval for access by the employer from the candidate who registered the purchased market information, when prior

Art Unit: 2164

approval is required (figs. 2a (elements 255, 260), and 2b, column 8, lines 7-14, and column 16, lines 26-59).

It would have been obvious to one of ordinary skilled in the art at the time the Applicant's invention was made to modify the teachings of Walker '207 to include the steps of determining, based on the personal information registered in said personal information registration means, whether prior approval by the consumer is required before the dealer accesses the consumer, and seeking approval for access by the dealer from the consumer who registered the purchased market information, when prior approval is required because, it benefits both the dealers and the consumers by better understanding of the consumer's needs such as privacy concerns when dealing with purchasing and by whom the consumer wants to be contacted, and better targeting of promotional programs for the dealers, and it provides a secure system by preventing any consumer's confidential information from being exposed to other dealers and marketing entities.

Claim 3, Walker '207 teaches the purchase of the market information by the dealer (column 13, lines 1-22).

Walker '207 fails to teach that the access confirming means cancels the purchase of the market information by the dealer when the consumer does not approve the dealer's access.

Walker '270 teaches that the access confirming means cancels the transaction when the party does not approve the requestor's access (fig. 6b, element 661, and column 16, lines 33-45).

It would have been obvious to one of ordinary skilled in the art at the time the Applicant's invention was made to modify the teachings of Walker '207 to include the step of canceling the

Art Unit: 2164

purchase of the market information by the dealer when the consumer does not approve the dealer's access because, it greatly improves the efficiency of the system by eliminating and reducing any unnecessary processing.

Claims 4, and 5, Walker '207 teaches that the personal information registered in said personal information registering means includes a type of access to the consumer (column 13, lines 1-53, and column 19, lines 55-60); and

the type of access includes at least one of indirect or direct electronic mail, indirect or direct facsimile transmission, indirect or direct mail of material, telephone call, and visit (column 13, lines 1-53, and column 19, lines 55-60).

Claim 6, Walker '207 teaches that the personal information registered in said personal information registering means includes pre-categorized information and format-free information (column 13, lines 1-53, and column 19, lines 55-60).

Claim 7, Walker '207 teaches that the accounting means for charging the dealer when the dealer has purchased the market information posted at said posting means (column 12, lines 35-53, and column 20, lines 16-30).

Claim 8, both Walker '207 and Walker '270 fail to teach the step of performing at regular intervals of time a process of inquiring of the consumer whether the consumer desires the market

Art Unit: 2164

information to be continuously posted at said posting means.

Official notice is taken that performing at regular intervals of time a process of inquiries is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to implement the system of Walker '207 to include the step of performing at regular intervals of time a process of inquiring of the consumer whether the consumer desires the market information to be continuously posted at said posting means because, it provides convenience to the consumer by keeping him/her updated of the posted information, it greatly improves the efficiency of the system by eliminating invalid postings, and provides both the consumers and the dealers with a system that is user friendly.

Claims 9, and 10, both Walker '207 and Walker '270 fail to explicitly teach the point providing means for giving the consumer a bonus point when the consumer has registered the personal information or market information; and

the point providing means gives the consumer an extra point if the consumer purchases goods from the dealer who has purchased the market information.

Official notice is taken that providing bonus points and incentives for registering personal information and more bonus points and incentives when purchasing goods and services is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to implement the system of Walker '207 to include the point providing means

Art Unit: 2164

for giving the consumer a bonus point when the consumer has registered the personal information or market information and when the consumer purchases goods from the dealer because, it provides the consumer the opportunity to save money on their purchases, and provides the dealers the chance to increase their sales.

Response to Arguments

9. Applicant's arguments filed October 23, 2001 have been fully considered but they are not persuasive.

In the remarks, the Applicant argues in substance that;

(a) The combination of Walker '207 and Walker '270 does not disclose the presently claimed invention. In particular, "Walker '207 combined with Walker '270 does not contain any suggestion of means "for acquiring personal information of the consumer necessary for the dealer to access the consumer" as recited in claim 1."

(b) Walker '207 does not contain any suggestions as claimed in claim 1 reciting "acquiring personal information ... after the market information ... is purchased by the dealer". "The cited portions of Walker '207 do not contain any suggestion that a seller purchases anything, in particular personal information of the buyers."

In response to (a):

As indicated in the previous office action mailed on May 22, 2001 and in the present office

Art Unit: 2164

action, Walker '207 clearly teaches the step of "acquiring personal information of the consumer necessary for the dealer to access the consumer" (column 19, lines 55-60). The fact that Walker '207 states that the communication between the buyer and seller can be anonymous is just one of the embodiments disclosed in the Walker '207 reference. Walker '207 (column 19, lines 55-60), clearly discloses another embodiment wherein the buyer and seller can communicate with each other directly. In rejecting this feature, the Examiner cited (column 13, lines 1-53) of Walker '207 to show the data storage devices storing information pertaining to the buyer and seller including personal information, contact information, and electronic mail and URL addresses. Also, (column 19, lines 55-60) was cited for rejecting the same feature to show the direct communication between the buyer and seller. In order for the one party to communicate directly with the other party, some of the personal information disclosed in (column 13, lines 1-53) has to be known to the other party. In addition, Applicant's specification (page 10, lines 4-7,) discloses the type of personal information registered in the personal information registration section, "such as demographic information and electronic mail address" that is necessary for the dealer to access the consumer. Therefore, the cited portions of Walker '207 (column 13, lines 1-53, and column 19, lines 55-60) teaches the claimed limitation of means "for acquiring personal information of the consumer necessary for the dealer to access the consumer" as recited in claim 1."

In response to (b):

In response to Applicant's argument that there is no suggestions in the portions cited of Walker '207 of "acquiring personal information ... after the market information ... is purchased by

Art Unit: 2164

the dealer”, and no suggestions that “a seller purchases anything, in particular personal information of the buyers.”.

It is unclear from Applicant’s arguments in the remarks whether the dealer is purchasing the market information or the personal information. The Examiner respectfully directs Applicant’s attention to the claimed limitations, (i.e. claim 1) states that “personal information registering means ...”, then “market information registering means ...”, and “... after the market information posted at said posting means is purchased ...”. Therefore, according to the claimed limitations what is purchased by the dealer is the market information not the personal information.

According to Applicant’s specification on (page 10 , lines 12-17), “... At this time, the corporate members select in advance the fields of their business activities, that is generates to browse, and pay a basic browsing charge for each of the selected browsing generates ...”, the same page (lines 21-22) states that “... and outputs the extracted information to the bulletin board 34.”. Walker (column 13, lines 11-22), teaches the use of a web page and a bulletin board which requires a basic browsing fee.

In addition, according to Applicant’s specification (pages 10-11), after the corporate member pays for the basic browsing fee and performs a search on the bulletin board for information, (page 11, lines 3-15) states that “when the corporate members pick up information on certain consumer members from the market information posted on the bulletin board 34, ...”, then the pickup processing section 35 performs the following steps:

“acquires the information necessary to access these consumer members”.

“causes the message processing section 36 to send an e-mail to the consumer for approval

Art Unit: 2164

of corporate member's access if the consumer member demands his/her approval before an actual access". And

"informs the accounting section 37 of purchase of the market information ...".

However, in analyzing the procedure of the flow chart of figure 5, and Applicant's specification (page 13, line 12 thru page 14, line 12) and in combination with figure 3, it is clear that the corporate members are able to pickup the market information based on the charge of the basic browsing fee, and if the consumer member does not approve the corporate member's approach, then the process is ended before the charging step is performed as indicated by element (S28, of figure 5). Therefore, based on this interpretation, claims 1, 3-12, and 14-16 were rejected. Walker '207 teaches the use of a web page and a bulletin board which requires a basic browsing fee (column 13, lines 11-22).

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2164

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

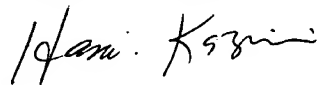
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 2100 or this Art Unit is (703) 746-7238 or 7239.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Respectfully Submitted


Hani.Kazimi

Art Unit 2164

February 12, 2002